UNITED STATES PATENT AND TRADEMARK OFFICE

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ART UNIT	PAPER NUMBER
2143	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
Office Action Summary	09/750,138	MALIK, DALE W.
	Examiner	Art Unit	
	George C. Neurauter, Jr.	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>03 January 2007</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,6-8,15 and 21-45* is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3, 6-8, 15, and 21-45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a)☐ All b)☐ Some * c)☐ None of:

    1.☐ Certified copies of the priority documents have been received.

    2.☐ Certified copies of the priority documents have been received in Application No. _____.

    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
  Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
  Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Claims 1-3, 6-8, 15, and 21-45 are currently presented and have been examined.

Response to Arguments

Applicant's arguments filed 3 January 2007 have been fully considered but they are not persuasive.

The Applicant argues that Shaffer does not teach or suggest the step of determining whether an electronic mail message has been previously compressed. The Examiner is not persuaded by these remarks in view of the teachings of Shaffer.

Shaffer discloses:

"According to the invention, when indicated by the connection or channel speed and the message or attachment size, a server makes a compressed version of the data file available for transmission." (column 7, lines 46-49)

"A system according to a specific embodiment of the invention can use artificial intelligence type analysis in media server 210 or a cooperating software component to determine when or how to compress messages..." (column 7, lines 11-14)

In view of the teachings of Shaffer and the knowledge of one of ordinary skill in the art, the server as able to determine whether an electronic mail message has been compressed by a predetermined criteria such as the message's size or some

other predetermined criteria and then, based on the indication,

compresses the message. By definition, compression of a data

file comprises the act of reducing the size of a file to some

value that is less than the original size of the file. Since the

claim fails to specifically recite and therefore require how a

message may be previously compressed in some other manner than

that is conventionally known, the server determines to compress

a message, for example, based on its message size, and <u>then</u>

compresses the file. As also shown in Shaffer, a file may be

compressed into a variety of <u>compressed formats</u> (column 8, lines

45-56). As shown by this disclosure in Shaffer and is also

conventionally known, a file may have an infinite number of

varying degrees of compression. Therefore, the Examiner has

interpreted the limitation "previously compressed" to mean that

the file is either in a compressed format at the time of

determination whether it has been compressed and therefore is

considered to be "previously compressed" or it is not

compressed, leading the server to compress the file. As shown

previously, the claim fails to specifically recite a specific

context in which a file is considered to be "previously

compressed". Therefore, in view of the teachings and suggestions

of Shaffer, Shaffer does disclose this limitation and the

currently presented claims are not in condition for allowance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs

of 35 U.S.C. 102 that form the basis for the rejections under

this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published
under section 122(b), by another filed in the United States before the
invention by the applicant for patent or (2) a patent granted on an
application for patent by another filed in the United States before the
invention by the applicant for patent, except that an international
application filed under the treaty defined in section 351(a) shall have the
effects for purposes of this subsection of an application filed in the
United States only if the international application designated the United
States and was published under Article 21(2) of such treaty in the English
language.

Claims 1-3, 6-8, 15, and 21-45 are rejected under 35

U.S.C. 102(e) as being anticipated by US Patent 6 842 768 B1 to

Shaffer et al.

Regarding claim 1, Shaffer discloses a method for

automatically managing an electronic mail server application on

a host computer, comprising the steps of:

checking an electronic mail message against a predetermined

criteria; determining whether the message has been previously

compressed; compacting ("compressing") a non-attachment portion

(referred to within the reference as "message") of the

electronic mail message if the predetermined criteria is

satisfied and if the message has not been previously compressed;

and storing the compacted electronic mail message. (column 7,

lines 46-51, specifically "...when indicated by...the

message...size, a server makes a compressed version of the data
file available for transmission. This compressed data file may
be prepared by the server by a compression engine 260 before a
user ever accesses an email account..."; column 6, lines, 65-67,
"The figure shows a representation of multimedia email system
210 with individual original messages 252 and !compressed (sp)
messages 254.")

Regarding claim 2, Shaffer discloses the method of claim 1,
wherein the step of checking is performed when the electronic
mail message is received by the electronic mail server
application. (column 3, lines 25-29, "Device 130 represents any
type of device or system or network that provides data to user
information appliances, such as, but not limited to...an email
server..."; column 7, lines 46-51, specifically "...when
indicated by...the message...size, a server makes a compressed
version of the data file available for transmission. This
compressed data file may be prepared by the server by a
compression engine 260 before a user ever accesses an email
account...") (Examiner's note: Note that it is inherent within
the reference that email servers receive and store messages for
clients before the clients access their email account).

Regarding claim 3, Shaffer discloses the method of claim 1,
wherein the step of checking is performed when the electronic

mail message is performed periodically on the host computer.
(column 7, lines 46-51, specifically "...when indicated by...the
message...size, a server makes a compressed version of the data
file available for transmission. This compressed data file may
be prepared by the server by a compression engine 260 before a
user ever accesses an email account or the file may be
compressed on-the-fly as a user logs in or as a user requests
download of a particular message")

Regarding claim 6, Shaffer discloses the method of claim 1,
wherein the predetermined criteria comprises a total message
size. (column 2, lines 39-48, specifically "...the size of the
data transfer...is used to select an appropriate compression
ratio for a message..."; column 7, lines 46-51, specifically
"...when indicated by...the message...size, a server makes a
compressed version of the data file available for
transmission.")

Regarding claim 7, Shaffer discloses the method of claim 1,
wherein the predetermined criteria comprises an attachment size.
(column 2, lines 39-48, specifically "...the size of the data
transfer...is used to select an appropriate compression ratio
for a...message attachment"; column 7, lines 46-51, specifically
"...when indicated by...the...attachment size, a server makes a

compressed version of the data file available for

transmission.")

Regarding claim 8, Shaffer discloses the method of claim 1,

wherein the predetermined criteria comprises an attachment type.

(column 2, lines 39-48, specifically "...the size of the data

transfer...is used to select an appropriate compression ratio

for a...message attachment"; column 7, lines 46-51, specifically

"...when indicated by...the...attachment size, a server makes a

compressed version of the data file available for

transmission."; column 8, lines 7-10, "Other parameters

according to the invention may indicate what decoding formats

can be handled by the client and therefore allow a server to

determine desired compression formats.")

Regarding claim 15, Shaffer discloses the method of claim

1, further comprising the step of compressing the attachment.

(column 2, lines 39-48, specifically "...the size of the data

transfer...is used to select an appropriate compression ratio

for a...message attachment"; column 7, lines 46-51, specifically

"...when indicated by...the...attachment size, a server makes a

compressed version of the data file available for

transmission.")

Regarding claim 21, Shaffer discloses a method for managing

a user's electronic mailbox on a computer, comprising the steps

of performing an off-peak hours routine (column 8, lines 30-34,

"An intelligent component of the system might also defer

performing any pre-compression while the computer system is

experiencing heavy use or might defer pre-compression") for

checking an electronic mail message against a predetermined

criteria; compressing a non-attachment portion of the electronic

mail message if the predetermined criteria is satisfied, wherein

the step of compressing the electronic mail message is performed

by searching for repeated patterns in the electronic mail

message and encoding those patterns (column 8, lines 45-56); and

storing the compressed electronic mail message. (column 7, lines

46-51, specifically "...when indicated by...the message...size,

a server makes a compressed version of the data file available

for transmission. This compressed data file may be prepared by

the server by a compression engine 260 before a user ever

accesses an email account..."; column 6, lines, 65-67, "The

figure shows a representation of multimedia email system 210

with individual original messages 252 and !compressed (sp)

messages 254.")

Regarding claim 22, Shaffer discloses the method of claim

21, wherein the step of checking is performed when the

electronic mail message is received by the electronic mailbox.

(column 3, lines 25-29, "Device 130 represents any type of

device or system or network that provides data to user

information appliances, such as, but not limited to...an email

server..."; column 7, lines 46-51, specifically "...when

indicated by...the message...size, a server makes a compressed

version of the data file available for transmission. This

compressed data file may be prepared by the server by a

compression engine 260 before a user ever accesses an email

account...") (Examiner's note: Note that it is inherent within

the reference that email servers receive and store messages for

clients in their respective accounts or "mailboxes" before the

clients access their email account).

Regarding claim 23, Shaffer discloses the method of claim

21, wherein the step of checking is performed upon request by

the user. (column 7, lines 46-51, specifically "...when

indicated by...the message...size, a server makes a compressed

version of the data file available for transmission. This

compressed data file...or the file may be compressed on-the-fly

as a user log ins or as a user requests download of a particular

message.")

Regarding claim 26, Shaffer discloses the method of claim

21, wherein the predetermined criteria comprises a total message

size. (column 2, lines 39-48, specifically "...the size of the

data transfer...is used to select an appropriate compression

ratio for a message..."; column 7, lines 46-51, specifically

"...when indicated by...the message...size, a server makes a

compressed version of the data file available for

transmission.")

Regarding claim 27, Shaffer discloses the method of claim

21, wherein the predetermined criteria comprises an attachment

size. (column 2, lines 39-48, specifically "...the size of the

data transfer...is used to select an appropriate compression

ratio for a...message attachment"; column 7, lines 46-51,

specifically "...when indicated by...the...attachment size, a

server makes a compressed version of the data file available for

transmission.")

Regarding claim 28, Shaffer discloses the method of claim

21, wherein the predetermined criteria comprises an attachment

type. (column 2, lines 39-48, specifically "...the size of the

data transfer...is used to select an appropriate compression

ratio for a...message attachment"; column 7, lines 46-51,

specifically "...when indicated by...the...attachment size, a

server makes a compressed version of the data file available for

transmission."; column 8, lines 7-10, "Other parameters

according to the invention may indicate what decoding formats

can be handled by the client and therefore allow a server to

determine desired compression formats.")

Regarding claims 30-32, Shaffer discloses the method of

claim 21, wherein the location of the screening of the message

is on a server, a client, or configured by a user. (column 2,

lines 39-48, specifically "...the size of the data transfer...is

used to select an appropriate compression ratio for a message...

In specific embodiments, a user may indicate (either at the time

of transfer, the time of login, or during client setup) an

acceptable delay or desired compression for a transfer."; column

7, lines 46-51, specifically "...when indicated

by...the...attachment size, a server makes a compressed version

of the data file available for transmission.")

Regarding claim 33, Shaffer discloses the method of claim

21, wherein the screening is performed periodically on the

computer. (column 7, lines 46-51, specifically "...when

indicated by...the message...size, a server makes a compressed

version of the data file available for transmission. This

compressed data file may be prepared by the server by a

compression engine 260 before a user ever accesses an email

account or the file may be compressed on-the-fly as a user logs

in or as a user requests download of a particular message")

Regarding claim 34, Shaffer discloses the method of claim

21, wherein the electronic mail message is compressed into a

zipped file. (column 8, lines 45-56, specifically "It should be

understood that a data file or a message may be encoded into a

variety of compression formats. Some of these formats, such as

...ZIP...have built-in variable compression.")

Claims 35-42 are also rejected since these claims recite a

computer readable medium that contain substantially the same

limitations as recited in claims 21-23, 33, 26-28, and 34

respectively.

Regarding claim 43, Shaffer discloses the method of claim

1, further comprising decompacting the compacted electronic mail

message for retrieval. (column 5, lines 30-44, specifically

"Optionally, there may also be a selectable option that a user

can use to indicate that the system should download a compressed

file or original file according to default rules. Selection by a

user is registered by the client-side logic (Step B3) and is

communicated so that the appropriate file format may be

transmitted (Step B4)."; column 8, lines 35-45, specifically

"The server maintains information about which algorithms are

available at a particular client and may learn from the client

from time to time which algorithms are available at the client

or desired by the user such as via a compression format list

250. According to a further embodiment, a server can in some

instances download to the client an application or applet 240 to

enable the client to handle a particular type of compressed file")

Claims 44 and 45 are also rejected since these claims recite a method and computer readable medium that contains substantially the same limitations as recited in claim 43.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is 571-272-3918. The examiner can normally be reached on Monday-Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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